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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,190	04/19/2007	Hiromi Inagaki	OCB-239-A	8992
21828 7590 09/16/2010 CARRIER BLACKMAN AND ASSOCIATES 43440 WEST TEN MILE ROAD EATON CENTER NOVI, MI 48375				
EXAMINER				
BURCH, MELODY M				
ART UNIT		PAPER NUMBER		
3657				
NOTIFICATION DATE		DELIVERY MODE		
09/16/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

cbalaw@gmail.com
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Office Action Summary

Application No.

10/593,190

Applicant(s)

INAGAKI ET AL.

Examiner

Melody M. Burch

Art Unit

3657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 19 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/CIS-8)
Paper No(s)/Mail Date 9/19/06, 5/1/09
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed 9/19/06 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because some of the references fail to include the inventor(s) and issue date as required by 37 CFR 1.98 (b)(1). It has been placed in the application file, but some of the information referred to therein (particularly, some of the US references) has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the guide groove" in line 4 from the bottom is

indefinite. It is unclear to the Examiner as to which guide groove Applicant intends to refer to since a plurality of guide grooves were previously recited.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4116307 to Reinecke.

Re: claim 1. Reinecke shows in figure 3 a parking brake system comprising: a parking piston (83) slidably fitted into a casing (82a, 82b) so that a parking brake state can be obtained by forward movement in response to a parking control fluid pressure acting on a rear face side of the parking piston; a lock mechanism provided within the casing to the rear of the parking piston (83) so as to automatically lock in response to forward movement of the parking piston in order to mechanically lock the parking piston at a forward position and unlock in response to a parking release control fluid pressure acting on the lock mechanism; a fluid pressure source (connected to element 89); and fluid pressure control means (89) for controlling a fluid pressure generated by the fluid pressure source so that the parking control fluid pressure and the parking release control fluid pressure can be obtained; the lock mechanism comprising a lock piston (92) that is slidably fitted into the casing to the rear of the parking piston so that at least

when the parking piston moves forward a forward urging force acts on the lock piston and that is arranged such that a parking release control pressure can act on the lock piston toward the rear, a cylindrical retaining tube (the rightmost o-ring on 83) that is integrally and coaxially connected to a rear part of the parking piston, at least one sphere (90) that are retained at least one position in the peripheral direction of the retaining tube so as to be movable in a direction along the radial direction of the retaining tube, and an insertion shaft (or integrally connected shaft portion to the left of 92) that is connected integrally to the front end of the lock piston so as to be axially relatively movably inserted into the retaining tube in order to sandwich the at least one sphere between the insertion shaft and the inner face of the casing while contacting the at least one sphere via intervening element from the inside of the retaining tube; the casing and the insertion shaft being formed so as to position the at least one sphere radially inward when the parking piston is at a retreat limit and position the sphere radially outward when the lock piston moves to a forward position in response to forward movement of the parking piston from the retreat limit, a plurality of guide grooves (92a) extending in the axial direction of the insertion shaft being provided on the outer face of the insertion shaft, the guide grooves having a concavely curved cross-sectional shape with a diameter that is equal to or larger than the diameter of the at least one sphere so that part of each of the at least one sphere is rollably fitted into the guide groove, and the casing having provided on the inner face a restricting step or incline of 82b that is capable of abutting, from the rear, against the sphere pushed radially outward by the insertion shaft when the lock piston is at the forward position.

With regards to the plurality of spheres, in *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

In *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) the court held that claims directed to a device which read on the prior art with the exception of the position of a component were unpatentable where switching the position of the component would not modify the operation of the device. In this case the spheres would move radially inward and/or outward along the guide groove whether the guide grooves were positioned on the inner surface of the hole or the outer surface of the insertion shaft.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7651175 to Inagaki in view of US Patent 4116307 to Reinecke. Claim 1 of the instant application and claim 1 of the '175 patent recite similar limitations except that the '175 patent claims that the guide grooves are on the inner face of the large diameter hole whereas the instant invention recites that the guide grooves are on the outer face of the insertion shaft.

In *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) the court held that claims directed to a device which read on the prior art with the exception of the position of a component were unpatentable where switching the position of the component would not modify the operation of the device. In this case the spheres would move radially inward and/or outward along the guide groove whether the guide grooves were positioned on the inner surface of the hole or the outer surface of the insertion shaft.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mmb
September 13, 2010

/Melody M. Burch/
Primary Examiner, Art Unit 3657